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In re Application of: WILLIAMS, SCOTT G.

Appl. No.: 10/051,488

Filed: Jan. 18, 2002

For: MULTIPURPOSE FOLDABLE CANDLE TOOL

Attorney's Docket # 4818-002

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: DECISION ON PETITION
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This is a decision on the petition filed on Mar. 15, 2006 by which petitioner requests supervisory review and withdrawal of the examiner's holding of abandonment for failure to place the dependent claims in independent form to avoid abandonment following the Decision on Appeal promulgated by the Board of Patent Appeals and Interferences (BPAI) on Aug. 12, 2005. The petition is considered pursuant to 37 CFR 1.181 and no fee is required.

The petition is dismissed.

In the petition, petitioner argues that the examiner's holding of abandonment was improper because petitioner believes the amendment filed on Dec. 5, 2005 would place the application in condition for allowance and the examiner could have issued an Office action to give the appellant another opportunity to address the deficiency.

The record shows that:

- 1) This application contains claims 1, 2, 4-16 and 18-24. In the Examiner's Answer of Jul. 1, 2004, the examiner rejected claims 1, 2, 4-12, 15, 16 and 18-24 and objected to dependent claims 13-14. No claims stand allowed.
- 2) On Aug. 12, 2005, the Board of Patent Appeals and Interferences (BPAI) issued a decision affirming the examiner's rejection of claims 1, 2, 4-8, 10-12, 15, 16 and 19-24 (see page 13 of the Decision). The Board also reversed the examiner's rejection to dependent claims 9 and 18. After the Decision was entered, the application was left with dependent claims 13 and 14 objected to by the examiner prior to the appeal and dependent claims 9 and 18 reversed by the Board under the appeal.
- 3) On Nov. 8, 2005, the examiner issued an Office action giving the appellant one month time period to present the dependent claims 9 and 18 in independent form to avoid abandonment. The Office action also indicated that no extension of time under 37 CFR 1.136(a) will be granted. Prosecution remains closed.
- 4) On Dec. 5, 2005, appellant filed an amendment canceling claims 1, 2, 4-8, 10-16 and 19-24 and adding new claims 25-42. The appellant also alleges that new independent claim 25 corresponds to previously pending claims 1 and 9, while new independent claim 39 corresponds to previously pending claims 15 and 18. New dependent claims 26 - 38 and

40 - 42 correspond to the previously pending dependent claims. Petitioner further argues that in the Board Decision, the Board reversed only the rejection of dependent claims 9 and 18. Petitioner also indicates that the newly added independent claims 25 and 39 include the limitations of allowable claims 9 and 18, respectively and new claims 25 - 42 stand in condition for allowance. In the amendment, the appellant requests the examiner to reconsider all rejections and allow the application.

- 5) On Jan. 31, 2006, the examiner issued a letter of abandonment because the appellant was given one month time period to place the dependent claims in independent form to avoid abandonment and that no extension of time would be granted, since prosecution was closed. In the abandonment letter, the examiner indicated that the new claims proposed on 12/05/05 would require further consideration.
- 6) On Mar. 15, 2006, the current petition was filed to request withdrawal of the holding of abandonment.

Discussion and Analysis

In the petition, petitioner states that when the Board overturned the rejection of a dependent claim and upheld the rejection of other dependent claims, the rules require that the allowable dependent claims be rewritten in independent form. This is correct in accordance with MPEP 1214.06 (I)¹. Appellant was required to place the dependent claims 9 and 18 in independent form as clearly stated in the Office action of Nov. 8, 2005. However, in the response to the Office action, the appellant indicates that the dependent claim 9 was re-written as new independent claim 25. This is incorrect because the original appealed dependent claim 9 was dependent upon the dependent claim 7 which further dependent upon the appealed independent claim 1. In the independent claim 25, the appellant omitted the limitations of claim 7 which requires the inclusion of "a wick cutter, a wick dipper for engaging a candle wick and submerging the candle wick within melted wax to extinguish the candle wick, and a match holder for engaging and holding a match". Therefore, the content of current independent claim 25 is not the same as the dependent claim 9. This new independent claim 25 was never presented before the Board.

In the response filed on Dec. 5, 2005, the appellant indicates that the dependent claim 18 was re-written as new independent claim 39. This statement is correct because the original appealed

¹ MPEP1214.06 [R-3] Examiner Sustained in Whole or in Part: I. NO CLAIMS STAND ALLOWED

The proceedings in an application or ex parte reexamination proceeding are terminated as of the date of the expiration of the time for filing court action. The application is no longer considered as pending. It is to be stamped abandoned and sent to abandoned files. In an ex parte reexamination proceeding, a reexamination certificate should be issued under 37 CFR 1.570. Claims indicated as allowable prior to appeal except for their dependency from rejected claims will be treated as if they were rejected. The following examples illustrate the appropriate approach to be taken by the examiner in various situations: (A) If claims 1-2 are pending, and the Board affirms a rejection of claim 1 and claim 2 was objected to prior to appeal as being allowable except for its dependency from claim 1, the examiner should hold the application abandoned. (B) If the Board or court affirms a rejection against an independent claim and reverses all rejections against a claim dependent thereon, ** after expiration of the period for further appeal, the examiner should proceed in one of two ways: (1) Convert the dependent claim into independent form by examiner's amendment, cancel all claims in which the rejection was affirmed, and issue the application; or (2) Set a 1-month time limit in which appellant may rewrite the dependent claim(s) in independent form. Extensions of time under 37 CFR 1.136(a) will not be permitted. If no timely reply is received, the examiner will cancel all rejected and objected to claims and issue the application with the allowed claims only.

dependent claim 18 was dependent upon the appealed independent claim 15. The independent claim 39 does contain all limitations of dependent claim 18 and independent claim 15.

Petitioner also questions that the status of the remaining dependent claims 2, 4-8, 10-12, 15, 16 and 19-24 and takes the position that amending the remaining dependent claims to depend from an allowable independent claim would place the application in condition for allowance. This position is unattainable because MPEP 1214.06 clearly states that "claims indicated as allowable prior to appeal except for their dependency from rejected claims will be treated as *if they were rejected*", *emphasis added*. Therefore, the previously indicated allowable dependent claims 13 and 14 prior to appeal were treated as they were rejected with other rejected dependent claims 2, 4-8, 10-12, 15, 16 and 19-24. The appellant also indicates that since the newly added dependent claims 26-38 and 40-42 were dependent upon allowable independent claims 25 and 39, respectively, then, these dependent claims are also allowable. The appellant further argues that the examiner should have entered the amendment filed on Dec. 5, 2005 and allowed the application. Petitioner's arguments are not convincing because the newly added dependent claims 26-38 and 40-42 and independent claim 25 raise new issues that require further consideration as clearly indicated in the letter of abandonment mailed on Jan. 31, 2006. Newly broadened independent claim 25 does not have the same scope of the dependent claim 9. A new consideration and search is required. With regard to newly added dependent claims 26-38, they also require new consideration because the combination of claims 26-38 previously was never dependent upon claim 9. The newly added dependent claims 40-42 were never dependent upon the subject matter of dependent claim 18. This also requires further consideration and search.

Finally, it should be noted that the Office action of Nov. 8, 2005, clearly stated that there are no allowable claims in the application, the applicant is given one month time period from the mailing date of this letter with no extension of time permitted in which to present the dependent claims 9 and 18 in independent form to avoid ABANDONMENT of the application. Since the prosecution is closed after the entry of Board's decision, any amendment, other than placing dependent claims 9 and 18 in independent form, is not allowed. In view of the fact that the appellant's amendment filed on Dec. 5, 2005 clearly does not place the application in condition for allowance for the reasons as stated above, the holding of abandonment is proper as stated in the Notice of Abandonment of Jan. 31, 2006 in accordance with MPEP 711.02².

Conclusion

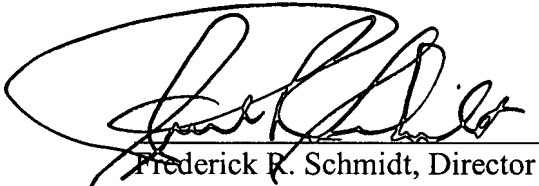
For the foregoing reasons it appears that the examiner's holding of abandonment was properly made. Therefore, there is no basis for granting the relief requested.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled

²MPEP 711.02 [R-3] Failure To Take Required Action During Statutory Period; 37 CFR 1.135(a) specifies that an application becomes abandoned if applicant "fails to reply" to an office action within the fixed statutory period. This failure may result either from (A) failure to reply within the statutory period, or (B) insufficiency of reply, i.e., failure to file a "complete and proper reply, as the condition of the case may require" within the statutory period (37 CFR 1.135(b)).

"Renewed Petition under 37 CFR 1.181." Alternatively, petitioners may wish to consider filing a petition to revive under 37 CFR 1.137 and RCE for further consideration of the amendment filed on Dec. 5, 2005. Any inquiry regarding this decision should be directed to Henry Yuen, Special Programs Examiner, at (571) 272-4856.

PETITION DISMISSED



Frederick R. Schmidt, Director
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